

REMARKS/ARGUMENTS

Claims 1 and 31 have been amended. Claims 12-18, 20, 22 and 29-38 are currently pending in this application.

Claims 12 and 31 have been amended to delete the term “followed by”.

New Matter

In the Final Office Action dated November 2, 2004, Examiner has alleged that claims 12-18, 20, 22 and 29-38 include new matter due to the addition of the phrase “followed by” after step a) of the claimed method and rejected these claims under 35 U.S.C. 112, first paragraph. Applicant respectfully disagrees with Examiners rejection.

Reference to the cited passage that was provided in Applicant’s response (page 11, lines 3-5) clearly states that “[t]he same sample dispensing tip...is sealed *after* the sample is aspirated into said tip” (emphasis added), indicating that the steps proceed in a step-wise fashion. Therefore, the amendment made to claim 12 to include the phrase “followed by” is not an addition of new matter as suggested by Examiner. In order to expedite prosecution of the present application, however, and without conceding to Examiner’s suggestion as to the addition of new matter, Applicant has elected to delete the phrase “followed by” from claims 12 and 31. The new matter objection against the pending claims has, therefore, been rendered moot.

In the amendment filed August 13, 2004, Applicant submitted that U.S. Patent No. 6,368,872 (Juranas) was not citable against claims 12-13 and 16 since the priority applications of the present application, namely, U.S. Provisional Application Serial No. 60/078,780, filed March 19, 1998 and International Application No. PCT/CA99/00236, filed March 19, 1999, provide support for the subject matter of those claims and the filing date of Juranus of October 22, 1999 does not precede the filing date of either one of the priority applications.

In particular, in the amendment filed August 13, 2004, Applicant respectfully asserted that U.S. Provisional Application Serial No. 60/078,780 provides support for the subject matter of the presently pending claims at, for example, page 10, lines 6 to 19 and

page 11, lines 1 to 12 of the description. In addition, it was respectfully asserted that the specification of International Application No. PCT/CA99/00236, which has a filing date of March 19, 1999, and from which the present application was filed as a continuation, also provides support for the subject matter of the presently amended claims at, for example, page 7, lines 9-11 and 31-32, page 8, lines 8-14; and page 10, lines 2-18 and 25-35.

As a result, Applicant is of the opinion that the subject matter of the presently pending claims is supported by the priority documents of the present application, and Juranus is, therefore, not citable against the presently amended claims.

Even if Juranus were citable against the present claims, Applicant respectfully submits that Juranus does disclose the presently claimed methods of the instant application. In particular, Applicant provides the following comments, which indicate the manner in which the method of the presently amended claims are distinguished from the prior art method disclosed in Juranus.

Juranus discloses a prior art method of sample processing, comprising extending a nozzle 22, mounted within sheath 18, beyond the end of the sheath, to engage the upper end of a molded pipette tip 30 and mount the pipette tip 30 onto nozzle 22 (see column 4, lines 15-19; FIGS. 2A and 2B). The mounted pipette tip 30 is next positioned over and lowered into a reagent contained in reservoir 32, and an amount of the reagent is suctioned into pipette tip 30 using an air pressure control source connected to nozzle 22 through tubing 26 (see column 4, lines 19-24 and 28-30). The mounted pipette tip containing the reagent is then positioned over a selected site on test grid 34, and the reagent is then released into the site by applying air pressure through nozzle 22 (see column 4, lines 33-29).

Juranus does not, however, disclose a method that includes step iii) or iv), as recited in the presently pending claims. In particular, Juranus does not disclose a method that comprises a step of inserting a second dispensing tip into a sealed first pipette tip containing a fluid and aspirating a portion or all of the fluid **from** the sealed first pipette tip **into** the second pipette tip, or a step of withdrawing a diluent or reagent into a second pipette tip and dispensing the diluent or the reagent into a sealed first dispensing tip

containing a fluid. At least for the reasons provided above, the presently pending claims are, therefore, novel over Juranus.

Based on the comments provided on page 2 of the Advisory Action dated December 16, 2004, Examiner appears to be of the opinion that the nozzle 22 of the prior art chemical sample processor 10, which is disclosed in Juranus, represents a pipette tip. Furthermore, Examiner appears to be of the opinion that in the operation of the prior art sample processor 10 fluid is drawn into the lumen of nozzle 22 from the pipette tip 30. It is respectfully submitted, however, that Examiner's interpretation of the operation of the processor 10 is incorrect. Although the nozzle 22 is similar in shape to the pipette tip 30, nozzle 22 is not a pipette tip, but is rather the terminal end of a pipette stem, which engages a pipette tip (column 4, lines 15-18).

Furthermore, in the described operation of the processor 10 in Juranus, fluid is never withdrawn into nozzle 22, as suggested by the Examiner, but is only suctioned into pipette tip 30. In addition, it is respectfully pointed out that withdrawal of fluid from the pipette tip 30 into the nozzle 22, as suggested by the Examiner, would defeat the whole purpose of the sample processor 10, which is to prevent cross contamination between different samples (see, for example, column 4, lines 6-8).


Accordingly, based on the foregoing comments, the presently pending claims are novel in view of Juranus.

It is respectfully submitted that the above-identified application is now in a condition for allowance and favorable reconsideration and prompt allowance of these claims are respectfully requested. Should the Examiner believe that anything further is desirable in order to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 19-0522.

Respectfully submitted,

By 
Gregory J. Skoch, Reg. No. 48,267
HOVEY WILLIAMS LLP
2405 Grand Boulevard, Suite 400
Kansas City, Missouri 64108
816/474-9050

ATTORNEYS FOR APPLICANT(S)